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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,328	08/17/2001	Raymond L. Rodriguez	50665-8009.US01	4810

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EXAMINER

FOX, DAVID T

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 05/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	09/932,328	Applicant(s)	Rodriguez et al
Examiner	FOX	Group Art Unit	1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on 3/6/03.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 1-7 and 18 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-6 is/are rejected.
- Claim(s) 7 and 18 is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

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Applicant's election without traverse of Group I in Paper No. 8 is acknowledged.

The application should be reviewed for errors. Errors appear, for example, in claim 6, line 4, where "[plant]" should be deleted. In addition, the instant specification and claims are inconsistent in their definition of the rice Gns9 promoter, or SEQ ID NO:1. Instant claims 1, 3, 6 and dependents identify the rice Gns9 promoter of SEQ ID NO:1 as a beta-glucanase promoter. Similarly, parent application Serial No. 09/344,438 which issued as U.S. Patent 6,284,956 claims a beta-glucanase promoter, and also characterizes the Gns9 promoter of SEQ ID NO:1 in this way (see, e.g., page 4 of the parent applications' specification, lines 8-9; page 5, line 4; and page 9, lines 33-34; corresponding to patent column 3, lines 40-42; column 7, line 67; column 8, lines 1-2). In addition, application Serial No. 09/105,390, which was incorporated by reference on page 11 of the instant specification, and which issued as U.S. Patent 6,288,303, characterizes the rice Gns9 promoter as a beta-glucanase promoter (see, e.g., column 2, lines 49-51 and 63-67; column 3, lines 1-14; column 7, lines 19-41; column 18, lines 13-46). However, the *instant specification* characterizes the Gns9 promoter of SEQ ID NO:1 as an *alpha*-glucanase gene promoter [emphasis added] on page 5, lines 1-3 and 33-34 and page 11, lines 8-10. Given the specifications of the parent application and the second application incorporated by reference herein, as well as the claims of the instant application, it appears that the instant application contains typographical errors in its designation of the Gns9 promoter as an alpha-glucanase gene promoter. Correction of these and all other errors is requested. New matter should be avoided.

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The specification is objected to under 37 CFR 1.821(d) for its omission of sequence identifiers on page 21, lines 19, 23, 30 and 33; and on page 22 at lines 16 and 19. If the current Sequence Listing contains these sequences, the specification should be amended to include the corresponding sequence identifiers. If the current Sequence Listing does not contain these sequences, Applicants should submit substitute paper copy and computer readable formats of the Sequence Listing, which include these sequences and which comply with 37 CFR 1.821-1.825.

This application is a continuation-in-part of parent application Serial No. 09/344,438 filed 25 June 1999, which claims priority to provisional application Serial No. 60/105,390 filed 25 June 1998. The parent application suggested and claimed a plant transformation vector comprising a rice Gns9 promoter operably linked to a gene encoding phosphinothricin acetyltransferase, taught SEQ ID NO:1 corresponding to the rice Gns9 promoter, and taught methods for rice transformation therewith. Accordingly, these concepts are afforded the effective filing date of the parent application. However, SEQ ID NO:4, which comprises the rice Gns9 promoter of SEQ ID NO:1, a particular phosphinothricin acetyltransferase coding sequence, and a particular NOS terminator sequence, as disclosed in instant Figure 5 and in Example 4 on pages 25-26 of the instant specification, was not taught in the parent application. Accordingly, claims drawn to SEQ ID NO:4 are afforded an effective filing date of the instant application, namely 17 August 2001. In addition, the parent application was silent with respect to detailed methods for wheat transformation, disclosed in Example 4 on pages 26-28 of the instant specification. Accordingly,

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the non-elected and cancelled claims drawn to wheat transformation would have been assigned an effective filing date of 17 August 2001.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 8-9 of U.S. Patent No. 6,284,956. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to utilize the method for rice transformation with a selectable marker gene comprising the callus-specific rice Gns9 promoter of

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SEQ ID NO:1 operably linked to a known coding sequence conferring resistance to a chemical selection agent and any 3' terminator sequence, wherein the selection agent is only included in the initial callus culture medium but is excluded from the plant regeneration culture medium, and rice plants transformed thereby, as claimed in the patent; to obtain the method for rice transformation with a selectable marker gene comprising the callus-specific rice Gns9 promoter of SEQ ID NO:1 operably linked to a known coding sequence conferring resistance to a chemical selection agent and any 3' terminator sequence, wherein the selection agent is only included in the initial callus culture medium but is excluded from the plant regeneration culture medium, and rice plants transformed thereby, as claimed in the instant application. Choice of known resistance gene would have been the optimization of process parameters.

The claims are free of the prior art, given the failure of the prior art to teach a selectable marker gene comprising the callus-specific rice Gns9 promoter of SEQ ID NO:1 or a callus-specific promoter which hybridizes thereto under highly stringent conditions, operably linked to a coding sequence conferring resistance to a chemical selection agent, and methods for its use for the obtention of transformed rice plants without chemical selection agent in the regeneration medium, as stated in parent application Serial No. 09/344,438, now U.S. Patent 6,284,956.

Claims 7 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No claim is allowed.

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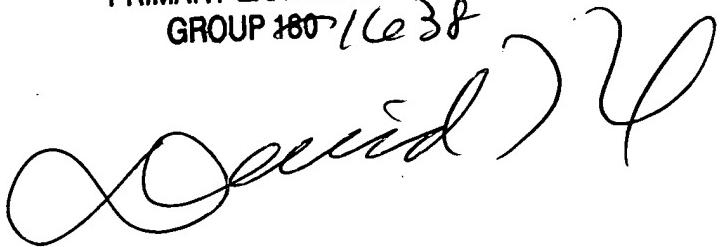
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

May 7, 2003

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 1638

A handwritten signature in black ink, appearing to read "David T. Fox". Above the signature, the name "DAVID T. FOX" is printed in a standard font. Below the printed name, "PRIMARY EXAMINER" and "GROUP 1638" are also printed. A small, handwritten "1638" is written above the "T" in "T. FOX".